



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,683	12/05/2003	Michael J. Gauer	200901536-1	9079
22879	7590	05/27/2010		
HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			EXAMINER THOMAS, ASHISH	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 05/27/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
ipa.mail@hp.com
laura.m.clark@hp.com



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/728,683
Filing Date: December 05, 2003
Appellant(s): GAUER, MICHAEL J.

Dan C. Hu
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 3/3/2010 appealing from the Office action mailed on 10/7/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
2-13, 15-20, 22-28, and 31-38.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

Art Unit: 2625

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,809,841	Brewster	10-2004
5,930,350	Johnson	7-1999
6,437,876	Phang	8-2002
2002/0051206	Masaki	5-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 7-13, 15-17, 20, 24, 25-28 31, 32, and 38 are rejected under 35

U.S.C. 103(a) as being unpatentable over Brewster(U.S. 6,809,841) in view of Johnson(U.S. 5,930,350) and further in view of Phang(U.S. 6,437,876).

Regarding claims 7, Brewster teaches a computer-implemented method for printing a document the method comprising: receiving document data from an application, the document data comprising data for printing at least a portion of the document; **(Figure 1, step 106 teaches sending a print job, and figure 1, step 108 teaches the reception of the print job at the printer.)** and formatting a page to be printed such that the page comprises at least a portion of the received document data and sender information, and the sender information is located outside document data areas and inside printer allowable margins. **(Figure 1, step 104 teaches an identification mark associated with the user's identification. This identification mark is an example of sender information. Figure 1, step 108 teaches that the identification mark is printed on each page of the print job. Column 3, lines 25-33 teaches that the mark associated with the user can be printed in a selected corner of the document. The selected corner can be categorized as an area that is outside the document data area yet within the allowable print boundaries.)**

Brewster merely teaches an identification mark that is selected by the user. Brewster does not teach actually accessing information associated with a sender of the document data.

Johnson, on the other hand, teaches accessing information associated with a sender of the document data. **(The abstract teaches receiving print jobs, identifying the sender of the print jobs, and retrieving information about the sender from a database.)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster with Johnson to realize a method that receives document data for a print job, accesses information associated with the sender of the print job, and then prints the received document data and accessed sender information.

The motivation here is to access sender data that might not be readily available with the print job. Also, not including a great deal of sender data in the print job can make the transmission of the print job easier because of the lower memory usage.

The combination of Brewster and Johnson is silent on checking if certain data fits within document margins.

Phang, on the other hand, teaches checking if data falls within the printable document margins(**column 1, lines 55-65**).

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster and Johnson with Phang to put forth the subject matter claimed in claim 7.

The motivation is to ensure that a document is successfully printed. The checking process achieves the successful output of data by making sure that all data are printed within the allowable print margins.

Regarding claim 20, Brewster teaches a system comprising an apparatus comprising: a memory, wherein the memory is operable to store document data from an application, the document data comprising data for printing at least a portion of the document; (**Figure 1, step 106 teaches sending a print job, and figure 1, step 108**

Art Unit: 2625

teaches the reception of the print job at the printer. This, in turn, inherently teaches the apparatus as well as the memory stated in the claim language.) and a processor coupled to the memory, the processor operable to format a page to be printed such that the page comprises at least a portion of the received document data and sender information, and the sender information is located outside document data areas and inside printer allowable margins. **(Figure 1, step 104 teaches an identification mark associated with the user's identification. This identification mark is an example of sender information. Figure 1, step 108 teaches that the identification mark is printed on each page of the print job. Column 3, lines 25-33 teaches that the mark associated with the user can be printed in a selected corner of the document. The selected corner can be categorized as an area that is outside the document data area yet within the allowable print boundaries. The processor is inherently taught in the reference.)**

Brewster merely teaches an identification mark that is selected by the user. Brewster does not teach actually accessing information associated with a sender of the document data.

Johnson, on the other hand, teaches accessing information associated with a sender of the document data. **(The abstract teaches receiving print jobs, identifying the sender of the print jobs, and retrieving information about the sender from a database.)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster with Johnson to realize a system that

receives document data for a print job, accesses information associated with the sender of the print job, and then prints the received document data and accessed sender information.

The motivation here is to access sender data that might not be readily available with the print job. Also, not including a great deal of sender data in the print job can make the transmission of the print job easier because of the lower memory usage.

The combination of Brewster and Johnson is silent on checking if certain data fits within document margins.

Phang, on the other hand, teaches checking if data falls within the printable document margins(**column 1, lines 55-65**).

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster and Johnson with Phang to put forth the subject matter claimed in claim 20.

The motivation is to ensure that a document is successfully printed. The checking process achieves the successful output of data by making sure that all data are printed within the allowable print margins.

Regarding claim 24, Brewster teaches an article of manufacture comprising a machine-readable medium that stores instructions operable to cause one or more machines to perform operations(**Column 3, lines 10-12**) comprising: determining whether document data from an application has been received, the document data comprising data for printing at least a portion of the document; (**Figure 1, step 106 teaches sending a print job, and figure 1, step 108 teaches the reception of the**

Art Unit: 2625

print job at the printer. This, in turn, inherently teaches the determining operation.) and formatting a page to be printed such that the page comprises at least a portion of the received document data and sender information, and the sender information is located outside document data areas and inside printer allowable margins. **(Figure 1, step 104 teaches an identification mark associated with the user's identification. This identification mark is an example of sender information. Figure 1, step 108 teaches that the identification mark is printed on each page of the print job. Column 3, lines 25-33 teaches that the mark associated with the user can be printed in a selected corner of the document. The selected corner can be categorized as an area that is outside the document data area yet within the allowable print boundaries.)**

Brewster merely teaches an identification mark that is selected by the user. Brewster does not teach actually accessing information associated with a sender of the document data.

Johnson, on the other hand, teaches accessing information associated with a sender of the document data. **(The abstract teaches receiving print jobs, identifying the sender of the print jobs, and retrieving information about the sender from a database.)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster with Johnson to realize an article of manufacture comprising a machine-readable medium that stores instructions operable to receive document data for a print job, access information associated with the sender

Art Unit: 2625

of the print job, and then print the received document data and accessed sender information.

The motivation here is to access sender data that might not be readily available with the print job. Also, not including a great deal of sender data in the print job can make the transmission of the print job easier because of the lower memory usage.

The combination of Brewster and Johnson is silent on checking if certain data fits within document margins.

Phang, on the other hand, teaches checking if data falls within the printable document margins(**column 1, lines 55-65**).

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster and Johnson with Phang to put forth the subject matter claimed in claim 24.

The motivation is to ensure that a document is successfully printed. The checking process achieves the successful output of data by making sure that all data are printed within the allowable print margins.

Regarding claim 31, Brewster teaches a system comprising memory for storing document data received from an application, the document data comprising data for printing at least a portion of the document; **(Figure 1, step 106 teaches sending a print job, and figure 1, step 108 teaches the reception of the print job at the printer. This, in turn, inherently teaches the apparatus as well as the memory stated in the claim language.)** and a means for formatting a page to be printed such that the page comprises at least a portion of the received document data and sender

Art Unit: 2625

information, and the sender information is located outside document data areas and inside printer allowable margins. **(Figure 1, step 104 teaches an identification mark associated with the user's identification. This identification mark is an example of sender information. Figure 1, step 108 teaches that the identification mark is printed on each page of the print job. Column 3, lines 25-33 teaches that the mark associated with the user can be printed in a selected corner of the document. The selected corner can be categorized as an area that is outside the document data area yet within the allowable print boundaries. The processor is inherently taught in the reference.)**

Brewster merely teaches an identification mark that is selected by the user. Brewster does not teach a means for actually accessing information associated with a sender of the document data.

Johnson, on the other hand, teaches accessing information associated with a sender of the document data. **(The abstract teaches receiving print jobs, identifying the sender of the print jobs, and retrieving information about the sender from a database.)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster with Johnson to realize a system that receives document data for a print job, accesses information associated with the sender of the print job, and then prints the received document data and accessed sender information.

The motivation here is to access sender data that might not be readily available with the print job. Also, not including a great deal of sender data in the print job can make the transmission of the print job easier because of the lower memory usage.

The combination of Brewster and Johnson is silent on checking if certain data fits within document margins.

Phang, on the other hand, teaches checking if data falls within the printable document margins(**column 1, lines 55-65**).

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster and Johnson with Phang to put forth the subject matter claimed in claim 31.

The motivation is to ensure that a document is successfully printed. The checking process achieves the successful output of data by making sure that all data are printed within the allowable print margins.

Regarding claims 8, 25, and 32, Phang further teaches initiating an alert if the data cannot fit within the printable margins(**column 1, lines 64-67**). Therefore, it would be obvious to alert the user if the accessed information for the formatted page does not fit between the document margin data areas and printer allowable margins.

Regarding claims 9 and 26, Phang teaches allowing format of information to be changed if an alert is initiated(**Column 2, lines 25-35**). Therefore, it would be obvious to allow the format of the accessed information to be changed if an alert is initiated.

Regarding claims 10 and 27, Johnson teaches associating the received document data with the sender of the document data(**Abstract teaches this**).

Furthermore, figure 2a illustrates a correlator 118 that allows a print manager to correlate data with users.).

Regarding claim 11, Johnson teaches that associating the received document data with a sender of the document data comprises determining a sender identifier accompanying the document data. **(Abstract and Figure 2)**

Regarding claim 12, Johnson teaches that accessing information associated with a sender of the document data comprises querying a database comprising sender associated information. **(Abstract teaches a database. And data is retrieved from the database. This reads on the querying process.)**

Regarding claims 13, Brewster further teaches generating a printer message comprising the formatted page. **(Figure 1, step 108 teaches that a page is printed. Note that the Examiner is interpreting the generation of a printer message simply as a printout step.)**

Regarding claim 15, Brewster teaches that document data includes data relating to appearance and content of a document. **(Column 2, lines 62-67)**

Regarding claim 16, Brewster further teaches that the processor is operable to format the document data in relation with formatting requirements associated with a printer. **(Column 2, lines 43-47)**

Regarding claim 17, Brewster further teaches that the apparatus comprises a printer driver. **(Column 2, lines 50-52)**

Regarding claims 28 and 38, Johnson further teaches that accessing information associated with the sender of document data comprises accessing information identifying the sender. **(Abstract and figure 2)**

II. **Claims 2-6, 18, 19, 22, 23, and 34-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster(U.S. 6,809,841) in view of Johnson(U.S. 5,930,350), Phang(U.S. 6,437,876), and Masaki(U.S. 2002/0051206).

Regarding claims 2, 18, and 22, the combination of Brewster, Johnson, and Phang teaches the subject matter claimed in the respective base claims. Note that this combination also teaches initiating an alert if accessed information does not fit between the document data and the printer allowable margins.

But this combination does not teach receiving a request to format information associated with a sender of document data, and generating a user interface that allows formatting of information associated with a sender of document data.

Masaki, on the other hand, teaches receiving a request to format information associated with a sender of document data(**Paragraph 45 teaches adjusting print position of header and footer. As illustrated in paragraph 47 and figure 5, to adjust the print positions, a user interface is used. Note that adjusting the print position of header information is an example of formatting sender info since the header information contains the name of the sender.**), and generating a user interface that allows formatting of information associated with a sender of document data(**Figure 5 and paragraph 47 teach a user interface displayed on the CRT 10.**).

Art Unit: 2625

Therefore, it would have been obvious, for one of ordinary skill in the art, at the time of the present invention, to modify Brewster, Johnson, and Phang with Masaki to put forth the subject matter claimed in claims 2, 18, and 22.

The motivation here is to provide the user with the opportunity to designate the layout settings in a manner he/she desires.

Regarding claim 3, Masaki further teaches that the user interface allows specification of the orientation in which information associated with a sender of document is placed on the page, wherein the orientation is selectable from one of plural possible orientations. **(Paragraph 47 discusses print positions such as right side setting, centering, and so on. This is an example of orientation. Furthermore, the concept of plurality of orientations is inherently taught in the reference.)**

Regarding claim 4, Masaki further teaches that the user interface allows specification of information associated with a sender of document data. **(Paragraph 47 teaches “specification of...kind of information to be printed as header/footer information.”)**

Regarding claim 5, Masaki further teaches that the user interface allows specification of the presentation style of information associated with a sender of document data. **(The position of sender information in a page can be one aspect of the presentation style. Note that paragraph 47 teaches print positions of the sender information.)**

Regarding claim 6, Masaki teaches that the user interface allows specification of the location of the information associated with a sender of document data. **(Print**

positions of sender data, detailed in paragraph 47, read on the location of sender data.)

Regarding claims 19 and 23, Masaki further teaches that the user interface allows specification of the content and appearance of information associated with a sender of document data. **(Paragraph 47)**

Regarding claims 34-37, the combination of Brewster, Johnson, and Phang teaches the subject matter claimed in the respective base claims.

But this combination is silent on an application that facilitates displaying and editing the document.

Masaki further teaches an application that facilitates displaying and editing the document. **(Figure 5 illustrates that a document is displayed while the user specifies certain settings. The change made to certain print settings is an example of an editing process.)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster, Johnson, and Phang with Masaki to fully put forth the subject matter claimed in claims 34-37.

The motivation here is to provide the user with the opportunity to designate the layout settings in a manner he/she desires.

III. Claims 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster(U.S. 6,809,841) in view of Johnson(U.S. 5,930,350), Masaki(U.S. 2002/0051206), and Phang(U.S. 6,437,876).

Regarding claim 33, Brewster teaches a computer-implemented method for printing a document, the method comprising: receiving document data from an application, the document data comprises data for printing at least a portion of the document(**Figure 1, step 106 teaches sending a print job, and figure 1, step 108 teaches the reception of the print job at the printer. Furthermore**); and formatting a page to be printed such that the page comprises at least a portion of the received document data and sender information, and the sender information is located outside document data area and inside printer allowable margins. (**Figure 1, step 104 teaches an identification mark associated with the user's identification. This identification mark is an example of sender information. Figure 1, step 108 teaches that the identification mark is printed on each page of the print job. Column 3, lines 25-33 teaches that the mark associated with the user can be printed in a selected corner of the document. The selected corner can be categorized as an area that is outside the document data area yet within the allowable print boundaries.**)

But Brewster is silent on determining an identifier associated with a sender of document data; and accessing information associated with the sender identifier, including querying a database comprising sender associated information.

Johnson teaches determining an identifier associated with a sender of document data; and accessing information associated with the sender identifier, including querying a database comprising sender associated information. (**The abstract teaches receiving print jobs, identifying the sender of the print jobs, and retrieving information about the sender from a database.**)

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster with Johnson to realize a method that receives document data for a print job, accesses information associated with the sender of the print job, and then prints the received document data and accessed sender information in such a way that the accessed sender information is located outside document data areas and inside printer allowable margins.

The motivation here is to access sender data that might not be part of the print job. Also, not including a great deal of sender data in the print job can make the transmission of the print job easier because of the lowered memory usage.

The combination of Brewster and Johnson does not teach an application that facilitates displaying and editing the document; generating a user interface that allows formatting of content, location, orientation, and appearance of information; and generating a printer message comprising the formatted page.

Masaki, on the other hand, teaches an application that facilitates displaying and editing the document(**Figure 5 illustrates that a document is displayed while the user specifies certain settings. The change made to certain print settings is an example of an editing process**); generating a user interface that allows formatting of content, location, orientation, and appearance of information associated with a sender(**Paragraph 45 teaches inputting sender information at an user interface; this is an example of formatting the content. Paragraph 45 also teaches setting the position of the sender info; this, in turn, has some type of effect on the location, orientation, and appearance of the sender information.**); and generating a

Art Unit: 2625

printer message comprising the formatted page. (**Printer 1500 in figure 2 prints the data. Note that the generation of a printer message, as stated in the claim language, is equated to the act of printing.**)

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster and Johnson with Masaki to put forth a print method that allows a user to edit a document in such a way that the user can specify the position of sender information.

The motivation here is to provide the user with the opportunity to designate the layout settings in a manner he/she desires.

The combination of Brewster, Johnson, and Masaki fails to teach checking whether the formatted page fits between the document data areas and printer allowable margins, and initiating an alert if the page does not fit between the document data areas and the printer allowable margins.

Phang teaches checking whether the formatted page fits between the document data areas and printer allowable margins(**column 1, lines 55-65**), and initiating an alert if the page does not fit between the document data areas and the printer allowable margins(**column 1, lines 64-67**).

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Brewster, Johnson, and Masaki with Phang to put forth print method that checks whether the accessed information for the formatted page fits between the document data areas and printer allowable margins, and initiates

Art Unit: 2625

an alert if the accessed information for the formatted page does not fit between the document data areas and the printer allowable margins.

The motivation is to ensure that a document is successfully printed. The checking process achieves the successful output of data by making sure that all data are printed within the allowable print margin.

(10) Response to Argument

I. Claims 7, 10-13, 24, 27, 28, 31, and 38

A. In page 8, lines 3-8 of the Appeal Brief, the Appellant states that "the Examiner cited column 1, lines 55-65, of Phang as purportedly disclosing the following: wherein formatting a page to be printed comprises checking whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins."

In response, the Examiner respectfully disagrees with the Appellant's characterization of the Final Rejection. Indeed, the Phang reference by itself does not teach that formatting a page to be printed comprises checking whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins. Rather, it is the combination of Brewster, Johnson, and Phang that teaches this concept. Please note that the Phang reference was simply used to point out the ability to check if data can be printed within the allowed margins(pages 4 and 5 of the Final Rejection).

B. In page 8, line 20- page 9, line 2 of the Appeal Brief, the Appellant argues that "in Phang, the checking that is performed is checking whether the user-selected

Art Unit: 2625

margins encroach and pass a boundary into an unprintable area of a medium." This type of checking disclosed in Phang, the Appellant asserts, is not the same as "checking whether the accessed information(associated with a sender of the document data) for the formatted page fits between the document data areas and the printer allowable margins." In page 9, lines 4-8 of the Appeal Brief, the Appellant further points out that "Phang would have absolutely no desirability or need to check whether accessed information associated with a sender of document data can fit between data areas and print allowable margins, since what Phang does is to check whether the entire work area as defined by user-selected margins are within printer boundaries, which is fundamentally quite different from the subject matter of claim 7."

In response, the Examiner firmly posits that the combination of Brewster, Johnson, and Phang obviously teaches the subject matter of claim 7. In order to fully refute the Appellant's arguments, a thorough review of the Final Rejection will be provided below. First, the Examiner will address the formulation of the rejection. Second, the Examiner will discuss the legitimacy in the usage of the Phang reference since the Appellant's assertions primarily harp on the usage of this reference.

Brewster teaches the concept of two areas on a page: one for the document data and another for an identifier associated with a user(Column 3, lines 22-35 of Brewster). Brewster also suggests that the identifier associated with the user could be located outside the document data area but within the printer allowable margins(column 3, lines 25-30). The claim language though defines a page comprising of "at least a portion of the received document data and the accessed information." The identifier

Art Unit: 2625

associated with the user, as described in the Brewster reference, may not be unequivocally categorized as accessed information of the sender. The Johnson reference teaches the concept of accessing information of the sender(Abstract).

Therefore, Brewster and Johnson can be combined to put forth the following limitations in claim 7: "accessing information associated with a sender of the document data; and formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information, and the accessed information is located outside document data area and inside printer allowable margins." It must be noted that the Appeal Brief does not contain arguments refuting the combination of Brewster and Johnson in realizing the above-cited limitations.

Brewster and Johnson fail to identify "checking whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins." Phang does not teach this limitation either. Phang though teaches, as the Appellant correctly points out in page 9, lines 4-8 of the Appeal Brief, the ability to check whether the entire work area as defined by user-selected margins are within printer boundaries(column 1, lines 55-65 and column 2, lines 15-55 of Phang). It then follows that the combination of Brewster, Johnson, and Phang obviously realizes "checking whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins."

The use of the Phang reference in the rejection qualifies as one of the rationales-applying a known technique to a known device(method or product) ready for improvement to yield predictable results-for combining references as

Art Unit: 2625

outlined in *KSR v. Teleflex*. Brewster and Johnson teach a “base” process of formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information. The claimed invention can be seen as an “improvement” of the “base” process since the claimed invention checks whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins. Phang contains a “known technique” of checking whether a work area is within the printer boundaries. Phang’s “known technique” of checking whether a work area is within the printer boundaries would have been recognized by one of ordinary skill in the art as being applicable to the “base” process of formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information. The “predictable result” of this combination would have been checking whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins.

The claimed invention, simply put, discloses the ability to differentiate between two areas and check if data will fit within one of the areas. As established before, Phang teaches the ability to check if data fits within certain boundaries(column 2, lines 15-55). While the data disclosed in Phang is not “accessed information”, the fact still remains that Phang has the ability to determine the printable boundaries and check if data will fit within those boundaries. The technology to check if data falls within permitted boundaries will allow one of obvious skill in the art to devise other obvious variants of the same technology. One such obvious variant is the claimed invention.

Art Unit: 2625

That is, Phang can be used to realize a more specific activity such as checking if the “accessed information” can fit within the document data areas and the printer allowable margins as claimed in the claim language. After all, the document data areas and the printer allowable margins stated in the claim language establish the printable boundaries for the “accessed information.” And Phang teaches the ability to determine the printable boundaries and checking if data falls within those boundaries. So, the predictable result of checking whether the “accessed information” for the formatted page fits between data areas and the printer allowable margins can be yielded from combining Phang with Brewster and Johnson.

C. In page 10, lines 1-6 of the Appeal Brief, the Appellant contends that “Examiner has actually used impermissible hindsight to propose a modification of the teachings of the cited references to achieve the claimed subject matter.”

In response, the Examiner respectfully disagrees with the Appellant. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The mere ability to check if data falls within a printable boundary, as disclosed in the Phang reference, is well known in the art. It is preferred to fit data, whether it be document data, header information, footer information, or any other type of information, within a designated boundary. Such a method would enable the successful output of all

Art Unit: 2625

data. This motivation is a prevalent one and is not one that is found solely in the claimed invention. The mere desire to ensure a successful printout of all data could motivate one of ordinary skill in the art to devise a method that ensures that data categorized as "accessed information" is also successfully printed out.

D. In page 10, lines 7-16 of the Appeal Brief, the Appellant argues against the *KSR* rationale advocated by the Examiner. Appellant states that "checking whether the accessed information associated with a sender of document data for the formatted page fits between the document data areas and printer margins as claimed is not a 'known technology' that can be applied to a known device ready for improvement to yield predictable results."

In response, the Examiner respectfully disagrees with this characterization of the Examiner's use of the *KSR* rationale. Please note that the Examiner is not equating the concept of "checking whether the accessed information associated with a sender of document data for the formatted page fits between the document data areas and printer margins" to a "known technology." Rather, Phang's "known technology" of checking whether a work area is within the printer boundaries would have been recognized by one of ordinary skill in the art as being applicable to Brewster and Johnson's "base" process of formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information. The combination of all three references would yield the "predictable result" of checking whether the accessed information associated with a sender of document data for the formatted page fits between the document data areas and printer margins.

E. The Appellant referred to the arguments corresponding to claim 7 (summarized in sections A through D above) for claims 24 and 31 as well. For this reason, the Examiner's responses outlined in Sections A through D also apply to claims 24 and 31.

II. Claims 15-17 and 20

The Appellant referred to the arguments corresponding to claim 7 for claim 20. For this reason, the Examiner's responses to the issues raised for claim 7 also apply to claim 20.

III. Claims 8, 9, 25, 26, and 32

A. In page 12, lines 1-14 of the Appeal Brief, the Appellant argues that "the concept of determining whether access information fits between document data areas and printer allowable margins clearly is not present in Phang, and therefore, a person of ordinary skill in the art would not have been led by Phang to the subject matter of claim 8." The Appellant asserts that column 1, lines 64-67 of Phang "states that a boundary-exceeded warning is presented if the user-selected margins are outside of the boundaries of the printer supported media...however, such boundary-exceeded warning is not initiated if the accessed information associated with a sender of the document data does not fit between the document data areas and the printer allowable margins."

In response, the Examiner points out once again that Phang alone does not teach the claimed subject matter, rather the combination of Brewster, Johnson, and Phang does. The explanation below utilizes one of the *KSR* rationales to explain the use of Phang in the rejection for claim 8.

The use of the Phang reference in the rejection qualifies as one of the rationales-applying a known technique to a known device(method or product) ready for improvement to yield predictable results-for combining references as outlined in *KSR v. Teleflex*. Brewster and Johnson teach a “base” process of formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information. The claimed invention can be seen as an “improvement” of the “base” process since the claimed invention initiates an alert if the accessed information for the formatted page does not fit between the document data areas and the printer allowable margins. Phang contains a “known technique” of alerting when a work area is not within the printer boundaries(column 1, lines 64-67). Phang’s “known technique” of alerting when a work area is not within the printer boundaries would have been recognized by one of ordinary skill in the art as being applicable to the “base” process of formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information. The “predictable result” of this combination would have been initiating a boundary-exceeded warning if the accessed information associated with a sender of the document data does not fit between the document data areas and the printer allowable margins.

B. In page 12, lines 14-18 of the Appeal Brief, the Appellant referred to the arguments corresponding to claim 8(summarized in section A above) for claims 25, 26, and 32 as well. For this reason, the Examiner’s responses outlined in Section A also apply to claims 25, 26, and 32.

IV. Claims 2-6 and 22

The Appellant referred to the arguments corresponding to claims 8 and 25 for claims 2-6 and 22. For this reason, the Examiner's responses to the issues raised for claims 8 and 25 also apply to claims 2-6 and 22.

V. Claims 18, 19, 23, and 34-37

The Appellant referred to the arguments corresponding to claims 7, 20, 24, and 31 for claims 18, 19, 23, and 34-37. For this reason, the Examiner's responses to the issues raised for claims 7, 20, 24, and 31 also apply to claims 18, 19, 23, and 34-37.

VI. Claim 33

The Appellant referred to the arguments corresponding to claim 8 for claim 33. For this reason, the Examiner's responses to the issues raised for claim 8 also apply to claim 33.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

/Ashish K Thomas/

Examiner, Art Unit 2625

David K. Moore

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625

Edward L. Coles

/Edward L. Coles/

Supervisory Patent Examiner, Art Unit 2625